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In re Application of
Gabriel V. Lechuga
Application No. 09/735,342
Filed: December 12, 2000
For: Heat Protective Cover System
For Hot Water Pipes

Director's Office
Group 3700 DECISION ON PETITION

This is a decision on the petition filed on April 29, 2004 by which petitioner requests supervisory review of, and relief from, the examiner's final restriction and election requirement. The petition is being considered pursuant to 37 CFR 1.144 and 37 CFR 1.181, and no fee is required. A refund of the \$130.00 petition fee tendered with the petition will be scheduled in due course.

The petition is dismissed.

A review of the record shows that on April 9, 2002, the examiner promulgated a requirement to elect between two groups of claims directed to patentably distinct inventions. Group I included claims 1-35 drawn to an insulation jacket, and Group II included claims 36-38 drawn to a fastener. The examiner held that these claims were directed to two different subcombinations useable together, and cited the practice set forth in MPEP § 806.05(c) as authority for the requirement that petitioner restrict the claims in this application to one group or the other. These requirements were repeated and made final in the Office action dated October 21, 2003.


Petitioner has argued that the fasteners of Group II are designed for use with the insulation jackets of Group I. Beyond that argument, petitioner has not adequately rebutted the examiner's basis for the restriction requirement as set forth in the above mentioned Office action. The examiner held that the fasteners, **as claimed**, could be used with other than the specific insulation jackets, **as claimed**, and that "any other objects" could be fastened together with such fasteners. The record does not show that petitioner has rebutted this premise, and petitioner has not shown that examiner's position is clearly erroneous. In addition, the examiner's statement that the two groups of claims represent inventions that have acquired a separate status in the art, as evidenced by separate classification, has not been rebutted. It appears, therefore, that as promulgated, and as made final, the examiner's restriction requirement was not arbitrary or capricious, was not an abuse of authority, and was well within the discretion to require restriction between patentably distinct inventions that has been conferred upon the Director of the Patent and Trademark Office by 35 USC § 121, and which has been delegated to the Primary Examiner.

In addition to the requirement to restrict between patentably distinct inventions, the examiner required petitioner to elect one of several species of insulation jacket for prosecution in this application. Petitioner has argued that the species identified by the examiner can be used together, and in fact, has stated that two jacket types are always used together. The relevance of this argument is not understood, since petitioner has claims directed to individual jacket types, as well as claims (which have been elected) to plural jacket types used together. It is, in any event, far from clear that petitioner's disclosure states that two jacket types are always used together. Further, it is noted that petitioner has never argued that the various species alleged by the examiner to be patentably distinct are in fact not patentably distinct. If the species are capable of supporting multiple patents, the examiner has every right to determine that only one such species will be examined (and allowed) in a given patent, absent a claim linking a plurality of such species. The examiner has alleged that there is no generic claim, and petitioner has not presented any convincing argument showing that this view is erroneous.

In summary, the examiner's action in requiring restriction between two groups of claims drawn to different subcombinations, and the examiner's action in further requiring an election of species with respect to the elected group of claims, has not been demonstrated to be clearly erroneous,

or to be arbitrary, capricious or an abuse of discretion. There is no basis for granting any of the relief requested. Petitioner may file a renewed petition, provided that it is filed within two months of the date of this Decision. See 37 CFR 1.181(f). This application is being forwarded to the examiner for action on the outstanding amendment that was filed concurrently with the petition.

PETITION DISMISSED.


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